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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09 895,518	06 28 2001	Ralf Wolleschensky	GK-ZEI-3100 500343.20096	8220

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EXAMINER

GEISEL, KARA E

ART UNIT	PAPER NUMBER
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2877

DATE MAILED: 02 24 2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/895,518

Applicant(s)

WOLLESCHENSKY ET AL.

Examiner

Kara E Geisel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 28 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6 and 8
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other \_\_\_\_\_

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## **DETAILED ACTION**

### ***Priority***

Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d).

The certified copy has been filed in this application on January 11<sup>th</sup>, 2002.

### ***Information Disclosure Statements***

The information disclosure statements filed on January 11<sup>th</sup>, 2002, March 29<sup>th</sup>, 2002 and June 7<sup>th</sup>, 2002 have been fully considered by the examiner.

### ***Specification***

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: the specification fails to provide proper antecedent basis for the subject matter in claims 2-10, including basis for pointwise illumination and detection, parallel illumination and detection, illuminating and detecting a microtiter plate, carrying out spectral splitting of a light emitted by a specimen, a dispersive element for spectral splitting, a multichannel detector, and switching off a detection channel, changing the amplification of a detection channel, changing the illumination parameters by feedback to a light source, and the signals of detection channel not being taken into consideration in further processing.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claims 2, 4, 6, and 8-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 2 recites the limitation "the light source" in line 2 and "the illumination parameters" in line 3. There is insufficient antecedent basis for these limitations in the claim.

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Claim 9 recites the limitation "the light" in lines 1-2 and "the specimen" in line 2. There is insufficient antecedent basis for these limitations in the claim.

Claims, which are dependent from claims 2 and 9 inherit the problems of these claims, and are, therefore also rejected under 35 U.S.C. 112, second paragraph.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1 and 2 are rejected under 35 U.S.C. 102(e) as being anticipated by Pyyhtiä et al. (USPN 6,248,990).

In regards to claim 1, Pyyhtiä discloses a method for the optical detection (column 1, lines 6-15) of an illuminated specimen (fig. 1, 12) in a plurality of detection channels (column 2, line 20) comprising assigning an upper and lower limiting value (column 2, lines 59-62) which is adjustable (column 6, lines 63-66) for at least one channel, and changing the channel to be detected with respect to its mode of operation when the limiting value is reached (column 5, lines 46-55).

In regards to claim 2, the mode of operation of the channel is changed by the signals of the detection channel are not taken into consideration in further processing (column 5, lines 46-55).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary.

Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 2-3 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pyyhtiä (USPN 6,248,990) in view of Ooki et al. (USPN 5,621,532).

In regards to claims 2 and 3, Pyyhtiä discloses the method for optical detection of an illuminated specimen in a plurality of detection channels, such as a CCD array as discussed above. Pyyhtiä does not disclose that pointwise illumination and detection is carried out. However, the CCD array of Pyyhtiä's system can be used in any optical measuring device, and it is well known to use CCD's in optical measuring devices, and therefore it would be obvious to put it in a device that carries out pointwise illumination of a specimen to be detected.

For example, Ooki discloses an optical detection device. The device includes a light source that illuminates the specimens (fig. 1, 1), and optical means to carry out pointwise illumination and detection (fig. 1, 2-4; column 2, lines 3-17). The light from the specimen is optically detected by a CCD array (fig. 1, 8 and column 6, lines 58-59). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use Ooki's arrangement of optical detection with Pyyhtiä's CCD detector array.

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Claims 5-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pyyhtiä (USPN 6,248,990) in view of Dickopf et al. (USPN 6,441,906).

In regards to claims 5 and 6, Pyyhtiä discloses the method for optical detection of an illuminated specimen in a plurality of detection channels, such as a CCD array as discussed above. Pyyhtiä does not disclose that parallel illumination and detection is carried out. However, the CCD array of Pyyhtiä's system can be used in any optical measuring device, and it is well known to use CCD's in optical measuring devices, and therefore it would be obvious to put it in a device that carries out parallel illumination of a specimen to be detected.

For example, Dickopf discloses an optical detection device. The device includes a light source that illuminates the specimens (fig. 3B, 62), and optical means to carry out parallel illumination and detection (fig. 5, column 4, lines 46-48 and column 7, lines 20-24). The light from the specimen is optically detected by a CCD array (fig. 5, 20). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use Dickopf's arrangement of optical detection with Pyyhtiä's CCD detector array.

In regards to claims 7 and 8, Dickopf's samples are located in a microtiter plate (fig. 3B, 60), which is illuminated and detected.

In regards to claims 9 and 10, Dickopf's apparatus further includes a dispersive element (fig. 3A, 9) for dispersion of the light emitted by the specimen (fig. 3B, 62) before a multichannel detector (fig. 3A, 20) detects the light.

#### ***Additional Prior Art***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Prior art made of record is Yang (USPN 5,214,274).

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Yang discloses a detector array for detection of an illuminated specimen, wherein the channels of the detector array have an upper limiting value, and wherein the mode of operation of a channel changes when the upper limiting value of the channel has been reached.

*Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kara E Geisel whose telephone number is 703 305 7182. The examiner can normally be reached on Monday through Thursday, 8am to 5pm and every other Friday 8am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frank Font can be reached on 703 308 4881. The fax phone numbers for the organization where this application or proceeding is assigned are 703 872 9318 for regular communications and 703 872 9319 for After Final communications. For inquiries of a general nature, the Customer Service fax number is 703 872 9317.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308 1782.

  
F.L. Evans  
Primary Examiner  
Art Unit 2877

KEG

KEG  
February 19, 2003